

REMARKS

The present amendment is in response to the Office action dated 27 February 2009, where the Examiner has rejected claims 1-7, 9-21 and 40-47. In the present amendment, claim 1 has been amended. Accordingly, claims 1-7, 9-21 and 40-47 are pending in the present application with claims 1, 13 and 40 being the independent claims. Reconsideration and allowance of pending claims 1-7, 9-21 and 40-47 in view of the following remarks are respectfully requested.

A. Status of Current Office Action

Applicant thanks the Examiner for the recognition of Applicant's prior request and for making the 27 February 2009 office action non-final.

B. 35 USC §102(e)

Claims 1-7, 9-21 and 40-47 stand rejected under section 102(e) as being anticipated by U.S. Publication No. 20020111865 ("Middleton") and also as being anticipated by US Patent No. 6,035,332 ("Ingrassia").

Independent Claim 1

Applicant notes that the 102 rejection of claim 1 set forth in the office action dated 27 February 2009 is nearly identical to the 102 rejection set forth in the 30 May 2008 office action and the 18 October 2007 office action. Applicant acknowledges the statement in the office action that the Examiner's position remains the same after full consideration of Applicant's arguments, which were not found to be persuasive. Applicant disagrees with the continuing rejection and incorporates its previous remarks herein.

Applicant further acknowledges the statement in the office action regarding the suggestion to add a certain limitation in order to expedite prosecution. Notwithstanding Applicant's disagreement with the rejection, Applicant has amended claim 1 to clarify that the event signal comprises "one or more tags that identify the location of one or more items of data" as suggested by the Examiner. This amendment is supported

throughout the specification and at least in paragraph 36 of the published application. Applicant respectfully asserts that for all of the reasons previously presented and for the additional reason that Middleton and Ingrassia to not disclose this new limitation, claim 1 and its respective dependent claims are presently in condition for allowance.

Independent Claim 13

The examination of independent claim 13 is inadequate. The 27 February 2009, 30 May 2008, and 18 October 2007 rejections of claim 13 are nearly identical and none of the rejections address the specific limitations of claim 13. The rejections are instead directed toward the language of claim 1 and consequently the rejections do not identify any portion of a cited reference that purportedly discloses each of the steps in claim 13. Accordingly, the 27 February 2009, 30 May 2008, and 18 October 2007 office actions have each failed to make a *prima facie* case of anticipation.

The examiner has the initial burden of establishing a *prima facie* case of anticipation by pointing out where all of the claim limitations appear in a single reference. See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). To anticipate a claim, the reference must teach each and every element of the claim. See, *MPEP* 2131. Additionally, for a claimed invention to be anticipated, all of the elements of the claim must be found in one reference. See *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Furthermore, it is improper to reject a claim without considering and addressing all of the claim limitations because "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

More specifically, claim 13 requires that the event tracking server receive a request from the network user and that the request includes a request to record event-tracking information. Additionally, claim 13 requires that the request be originally contained in a specially formatted Web page on the content server. Middleton and

Ingrassia do not disclose that a request that gets sent to the event tracking server is originally included in a specially formatted Web page on the content server. Nor does the office action suggest that Middleton and/or Ingrassia disclose these features.

A close review, however, demonstrates that the Middleton and Ingrassia references are not directed toward web content but rather they are concerned with downloading an applet to the client device that executes on the client device in order to monitor user activity and report that activity to an activity server (Middleton) or synchronization server (Ingrassia).

Finally, claim 13 requires that the request that is received by the event-tracking server is sent in response to an HTML code element that is extracted from the specially formatted Web page. This specific requirement that the event-tracking request is sent in response to an HTML code that is extracted from a specially formatted web page is not disclosed by Middleton or Ingrassia.

Middleton only discloses that the applet sends the monitored user activity report to the activity server at an appropriate time, such as when the display of the web page is terminated. This does not disclose sending a request to the event-tracking server in response to an HTML code element extracted from the specially formatted Web page, as required by claim 13. Ingrassia also does not disclose this requirement. Ingrassia only discloses that the applet running on the client reports the activities to a synchronization server. Ingrassia does not disclose that the reporting is carried out responsive to an HTML code element that is extracted from the specially formatted Web page.

In contrast to claim 13, both Middleton and Ingrassia disclose applet based solutions for monitoring user activity and these applets necessarily run separate from the browser and in the Java virtual machine. These applets do not send their respective activity logs to a server in response to an HTML code element that is extracted from a specially formatted web page. Instead they send their respective activity logs to a server at a predetermined time, such as when the display of the web page is terminated. Accordingly, applicant re-asserts that claim 13 is fully distinguished from

Middleton and Ingrassia and respectfully requests a notice of allowance that includes claim 13 and its respective dependent claims.

Independent Claim 40

The office action dated 27 February 2009 similarly fails to address the specific elements of claim 40. Instead, just as in the office action dated 30 May 2008, the office action lumps the 102 rejection of independent claim 40 together with a rejection that is directed toward the language of independent claim 1. The result of this grouping is a rejection that fails to address each of the elements of independent claim 40, which is insufficient to establish a *prima facie* case of anticipation. Based on the continuing failure to establish a *prima facie* case of anticipation, Applicant re-asserts that claim 40 is presently in condition for allowance and a notice of allowance of claim 40 and its respective dependent claims is respectfully requested.

Furthermore, with respect to the analysis of independent claim 40 in view of Middleton and Ingrassia, the steps of independent claim 40 are not disclosed by these references standing alone or using a combination of the two references. Both Middleton and Ingrassia are applet references. Each relies on an applet that is downloaded to the client device and executed by the Java virtual machine. As the applet executes on the client device, it monitors the user activity and then sends a report to a server. (see Abstract of Middleton and Ingrassia).

Independent claim 40 distinguishes the applet based monitoring described by Middleton and Ingrassia. Specifically, claim 40 requires that the content server receive an event from the client device, for example a request to include an item in a shopping cart. At this point, if this is the first request from the user, under Middleton and Ingrassia this first request does not get monitored because the applet has not yet been downloaded to the client and the applet is not yet running, so it cannot monitor this first event. This simple example of claim 40 against Middleton and Ingrassia fully demonstrates that these references do not and cannot disclose the claimed invention set forth in claim 40.

In further contrast, Ingrassia requires that the first request be responded to by the content server in order to cause the client device to make a second request to download the applet. (Fig. 3, element 4). That requirement clearly shows that Ingrassia fails to disclose the necessary elements of claim 40.

Next, claim 40 requires that the content server dynamically generates an event definition section that is associated with the event that just occurred such that the event definition section includes an event identifier and event definition data regarding the event that just occurred. These actions take place at the content server and no such content server actions are disclosed by Middleton or Ingrassia. Nowhere does the office action even attempt to provide any explanation or citation to a passage in any reference that discloses that the content server dynamically generates an event definition section that is associated with the event that just occurred.

Claim 40 also requires that the content server retrieve web page content that is responsive to the event and then insert the dynamically generated event definition section into the web page content and return the web page content with the event definition section to the client device. Nowhere does the office action even attempt to provide any explanation or citation to a passage in any reference that discloses that the content server dynamically generates an event definition section that is associated with the event that just occurred and then insert the dynamically generated event definition section into the web page content and return the web page content with the event definition section to the client device. These limitations are not disclosed by Middleton or Ingrassia and no office action to date has even suggested that these specific elements are disclosed.

As Applicant has previously explained, Middleton and Ingrassia fail to disclose any such content server actions because their disclosures are only directed toward applet based user monitoring and the applets execute at the user station within the context of a Java virtual machine that is associated with the browser.

Furthermore, claim 40 requires that the event tracking server receive an event signal from the client device and that the event signal includes the event definition

section that was dynamically generated by the content server. Middleton and Ingrassia only disclose that a log of monitored user activity is sent to the activity server (Middleton) or synchronization server (Ingrassia). Neither reference discloses that data regarding an event that just occurred is dynamically generated by the content server, inserted into the web page content that is sent to the client device, and then also sent to the event-tracking server, as required by claim 40.

Still further, claim 40 requires that the event-tracking server parse the event signal to obtain the event identifier from the event definition section and then get an instruction from a memory of the event-tracking server by using the event identifier. Middleton and Ingrassia do not disclose these event-tracking server actions because both references are focused on the applets that execute on the client device.

Accordingly, Applicant believes that amended claim 40 is clearly distinguished from Middleton and Ingrassia and respectfully requests a notice of allowance including at least claim 40 and its dependent claims.

C. Status of Next Office Action

Because the 27 February 2009 office action and the prior 18 May 2008 office action both failed to address each of the elements of independent claims 13 and 40 that were rejected in those office actions, both of the office actions have failed to establish a *prima facie* case of anticipation. Applicant therefore repeats its request that the next office action be made non-final unless it includes a notice of allowance for the pending independent claims. Applicant is entitled to a substantive examination of its pending claims that address each of the elements in those claims. The 27 February 2009 and 18 May 2008 office actions have failed to address all of the steps in independent claims 13 and 40 and therefore have failed to establish a *prima facie* case of anticipation for these independent claims as well as their respective dependent claims. For this reason too Applicant requests the status of the next office action be made non-final unless it includes a notice of allowance.

CONCLUSION

For all the foregoing reasons, allowance of pending claims 1-7, 9-21 and 40-47 is respectfully requested. If the Examiner believes that a telephone conversation may be useful in advancing prosecution, the Examiner is invited to contact the undersigned at the number listed below. If necessary, applicant requests to extend the period for filing this reply pursuant to 37 CFR 1.136(a) and authorizes the Director to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Procopio Deposit Account No. 50-2075.

Respectfully submitted,

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